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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,216	04/08/1999	TAKAFUMI ATARASHI	Q52648	2612

7590 09/23/2003

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EXAMINER	
PULLIAM, AMY E	

ART UNIT	PAPER NUMBER
1615	20

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/202,216	ATARASHI ET AL.	
	Examiner	Art Unit	
	Amy E Pulliam	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 June 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 9-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Receipt of Papers

Receipt is acknowledged of the Extension of Time and the Amendment B, both received by the Office June 24, 2003.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7, and 9-15 are rejected under the judicially created doctrine of double patenting over claims 1-6 of U.S. Patent No. 5,985,466, AND claims 1-13 of U.S. Patent No. 6,310,118, AND claims 1-20 of U.S. Patent No. 5,763,085, AND claims 1-3 of U.S. Patent No. 6,207,280, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim in not patentable distinct from the reference claim(s) because the examiner claim is either anticipated by , or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman,* 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other. Each of the cited patents and the application claim a multi-layer coated powder, wherein the coatings comprise metal oxides.

Specifically regarding Patent 5,985,466, the claims are broader than the claims of the instant application in not requiring a specific gravity, and are therefore anticipated by the claims of the application. However, looking to claim 6 of the patent, Applicant has recited the limitation to the equation in determining the thickness of the layers. This is identical to the equation found in claim 12 of the instant application.

Specifically regarding Patent 6,310,118, the claims are within the same scope as the instant application, in that both require a coated particle, wherein the coating layers differ from each other in refractive index and wherein the thickness is decided by the recited equation.

Specifically regarding Patent 5,763,085, the claims again overlap in scope with the application, in that both require a particle coated with metal oxides.

Lastly, regarding Patent 6,207,280, the claims overlap in scope with the application, in that both require a multi layer coated powder.

There is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 and 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Us Patent 5,061,317 to Korpi *et al.*

Korpi *et al.* disclose a new nacreous pigment and a method for its preparation. More specifically. Korpi *et al.* teach a color pigment based on metal- oxide coated mica particles or other layer silicate particles (abstract). Korpi *et al.* also teach that because of their advantagesous refractive index, titanium dioxide and/ or zirconium dioxide, is used for the metal oxide coating. The color of the pigment is dependent on the thickness of the titanium-dioxide coating and may vary from silver or gold color throughout the range to a red, blue, violet, or

green interference color (column 3, lines 5-12). Korpi *et al.* further teach that the coating may contain other metal oxides which impart additional color (column 3, lines 14-15).

Korpi *et al.* do not disclose the particular specific gravity of the base particle, or the interference peak or bottom of each coating layer. However, the Office does not have the facilities for examining and comparing applicant's product with the product of the prior art in order to establish that the product of the prior art does not possess the same material structural and functional characteristics of the claimed product. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed products are functionally different than those taught by the prior art and to establish patentable differences. *See Ex parte Phillips*, 28 U.S.P.Q.2d 1302, 1303 (PTO Bd. Pat. App. & Int. 1993), *Ex parte Gray*, 10 USPQ2d 1922, 1923 (PTO Bd. Pat. App. & Int.) and *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). Furthermore, it appears that the teachings of Korpi *et al.* achieve the same end result as Applicant, and therefore, absent evidence to the contrary, no criticality has been placed on the specific gravity of the base particle. Also, Applicant specifically claims metal oxides as the ideal coatings, and this is exactly the teaching of Korpi *et al.*. Based on the fact that Applicant and Korpi *et al.* apply the same coating materials, one skilled in the art would expect the characteristics of those layers to be the same.

Lastly, Applicant's new claim 15 states that the coating layers contain no dye or pigment. Although the reference teaches the presence of a dye or pigment, the examiner does not interpret this as teaching away from the invention, because both Korpi *et al.* and Applicant include the presence of titanium dioxide, which is a well known pigment. Therefore, the teachings of the reference are still consistent with the teachings of the claimed invention.

One skilled in the art would have created a powder, coated with metal oxides to create colors, based on the teachings of Korpi *et al.*. The expected result would be a powder with color. Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy E Pulliam whose telephone number is 703-308-4710. The examiner can normally be reached on Mon-Thurs 7:30-5:00, Alternate Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

A. Pulliam
Patent Examiner
Art Unit 1615
September 12, 2003

THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600